

Serial No. 10/054,257

Amend. In Resp. to Office Action of March 9, 2004

UTILITY PATENT

B&amp;D No. TN -2239

**REMARKS**

Applicants have amended Claim 1 and canceled Claim 8. Currently in the application therefore are Claims 1-7 and 9-16.

The Examiner objected to the specification under 37 CFR § 1.71. In particular, the Examiner alleged that the Specification does not point out "the functions of a tab 71A." In response, Applicants refer the Examiner to Paragraphs 0048 and 0049. According to the Specification, screw 73 must be unscrewed to bypass tab 71A, so that pivot plate 70 can be rotated. Furthermore, tab 71A also forces the user to move screw 73 to a certain position where the lower blade guard 32 will be blocked from returning to its original position. Thus, the functions of tab 71A have been described in the Specification.

The Examiner also objected to the Specification for failing to point out "whether an [sic] lower blade guard 32 being [sic] pivotable with respect to an upper blade guard." In response, Applicants refer the Examiner to Paragraph 0048. According to the Specification, the upper blade guard 31 may have a pivot plate 70. Pivot plate 70 in turn rotatably supports lower blade guard 32. In other words, lower blade guard 32 can rotate relative to pivot plate 70. Since pivot plate 70 is part of upper blade guard 31, lower blade guard 32 is thus rotatable relative to upper blade guard 31. The Examiner can find further information on the rotatable connection between pivot plate 70 and lower blade guard 32 in Paragraph 0053-0055 of the Specification and FIG. 16.

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The Examiner objected to the drawings under 37 CFR § 1.84 and requested formal drawings. In response, Applicants have amended FIGS. 1-16 to provide herewith formal drawings.

In addition, the Examiner notes that FIGS. 10-11 do not show how a lower blade guard 32 is secured to an upper blade guard 31 and the plate 70. Applicants are not required to show such connection. Under 37 CFR § 1.83(b), "[w]hen the invention consists of an improvement on an old machine the drawings must when possible exhibit... the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith."

In the present case, the invention of Claim 13 does not reside on the connection between the pivot plate and the lower blade guard, as such connection is well known in the prior art. Pursuant to such knowledge, Applicants provide FIG. 10 which shows only enough of the "old structure as will suffice to show the connection of the invention therewith." Such connection is shown as the double circle above the dotted circle referenced as "A" in FIG. 10. This double circle shows the typical pivotal connection between the lower blade guard and the pivot plate 70. The Examiner can find further information on the rotatable connection between pivot plate 70 and lower blade guard 32 in Paragraph 0053-0055 of the Specification and FIG. 16.

Furthermore, Applicants show the tabs claimed in dependent Claims 15-16, i.e., "the improved portion itself, disconnected from the old structure," as required by 37 CFR § 1.83(b). Since the requirements of Rule 83(b) have been met, the Examiner cannot object to the drawings.

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The Examiner also noted that it "is unclear that the plate 70 and lower blade guard 31 [sic] are disposed on one side or two sides of the upper blade guard 31." Applicants do not understand the Examiner's objection as such language is not found in the claims. Nonetheless, Applicants note that typical lower blade guards have two walls, each wall being on one side of the upper blade guard 31. Furthermore, while plate 70 is disposed on one side of upper blade guard 31, plate 70 also has at least one tab, e.g., 74, 75 and/or 76, which may extend to the other side of upper blade guard 31. See, e.g., FIGS. 12-13.

The Examiner objected to FIG. 2 for not matching FIG. 1. In particular, the Examiner notes that in FIG. 2, "it appears that the bottom of a table 12 rests on the top surface of a base assembly 11," whereas FIG. 1 shows both surfaces as being flush. Applicants note that the reason for such apparent discrepancy is the point of view of each figure. It is well known in the miter saw art that typical base assemblies 11 have two top surfaces with a space between for accommodating table 12. See, e.g., FIG. 7 of US Patent No. 6,431,042. Table 12 is disposed in such space. FIG. 1 shows such arrangement.

FIG. 2 however is a close-up showing base assembly 11 without those two surfaces on the sides of the space. From such point of view, table 12 is disposed on top of base assembly 11. Therefore, FIGS. 1-2 are clear.

The Examiner also noted that it was unclear whether the lower blade guard is pivotable with respect to the upper blade guard. As discussed above, Paragraph 0048 of the Specification describes that the upper blade guard 31 may have a pivot plate 70. Pivot plate 70 in turn rotatably

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supports lower blade guard 32. In other words, lower blade guard 32 can rotate relative to pivot plate 70. Since pivot plate 70 is part of upper blade guard 31, lower blade guard 32 is thus rotatable relative to upper blade guard 32. The Examiner can find further information on the rotatable connection between pivot plate 70 and lower blade guard 32 in Paragraph 0053-0055 of the Specification and FIG. 16.

The Examiner noted that the fixed and sliding fences in FIG. 1 are not differentiable. Applicants disagree, as the fixed fence has reference numeral "21," whereas the sliding fence has reference numeral "22." See Paragraph 0025 of the Specification. Applicants also refer the Examiner to US Patent No. 5,297,463, which was incorporated by reference in the Specification for further information on such fence assembly.

The Examiner also objected to the drawings because reference numerals "21" and "22" have been used to designate a sliding fence in Paragraph 0040. Applicants have amended the Specification to remove such typographical error.

The Examiner has rejected Claim 8 under 35 USC § 112, first paragraph, as not being enabled by the specification. Reconsideration and withdrawal of this rejection is respectfully requested.

While Claim 8 has been canceled, Claim 1 has been amended to include the subject matter of Claim 8. Accordingly, Applicants will respond to the Examiner's rejection as applicable to Claim 1.

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In the present case, the Examiner does not understand how a miter saw with a wear ring having an L-shape cross-section can function if the wear ring elevates the table above the base assembly, where in "order to function properly, both surfaces must be flush." First of all, in order for a miter saw to function properly, the surfaces of the table and the base assembly do not need to be flush.

Second, as discussed above, FIG. 2 is a close-up showing base assembly 11 without the two higher surfaces to the sides of the table. From such point of view, table 12 is disposed on top of base assembly 11. However, the two higher surfaces to the sides of table 12 could still be substantially coplanar with the top surface of table 12.

The Examiner also rejected Claims 13-16 under 35 USC § 112, first paragraph, as not being enabled by the specification. This rejection is respectfully requested.

In particular, the Examiner rejected Claim 13 because it is "unclear what [is] the function of the first tab 71A" as it appears that upper blade guard 31, lower blade guard 32 and plate 70 can be secured together without tab 71A.

Tab 71A does not play any role in securing the upper blade guard 31 to lower blade guard 32. Tab 71A does not play any role in securing plate 70 to lower blade guard 32. It does however play a role in how plate 70 interacts with upper blade guard 31.

According to Paragraphs 0048 and 0049 of the Specification, screw 73 must be unscrewed to bypass tab 71A, otherwise pivot plate 70 cannot be rotated to provide access to arbor A.

Furthermore, tab 71A also forces the user to move screw 73 to a certain position where the lower

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blade guard 32 will be blocked from returning to its original position. Thus, the functions of tab 71A have been described in the Specification.

The Examiner rejected Claims 1-7 and 9-11 under 35 USC § 102(e) as being anticipated by US Patent No. 6,431,042 ("Brault"). Reconsideration and withdrawal of this rejection is respectfully requested.

As mentioned above, Applicants amended Claim 1 to include the subject matter of Claim 8. Claim 8 was not rejected in view of Brault. Accordingly, Claim 1 is patentable over Brault.

The Examiner rejected Claim 9 under 35 USC § 102(e) as being anticipated by US Patent No. 6,418,830 ("Stumpf"). The Examiner also rejected Claim 10 under 35 USC § 103(a) as being obvious over Stumpf. These rejections are respectfully traversed.

Claim 9 calls for a miter saw comprising a base assembly, a table rotatably attached to the base assembly, a saw assembly pivotably attached to the table, a fixed fence attached to the base assembly, and a sliding fence slidably attached to the fixed fence, the sliding fence having at least one hole for fixing an end stop fixture thereto. Claim 10 is dependent upon Claim 9.

Admittedly, Stumpf shows a miter saw comprising a base assembly, a table rotatably attached to the base assembly, a saw assembly pivotably attached to the table, a fixed fence attached to the base assembly, and a sliding fence slidably attached to the fixed fence. However, Stumpf does not show the sliding fence having at least one hole for fixing an end stop fixture thereto. Indeed, the Examiner could not find such hole either, as the Examiner did not provide a reference to Stumpf showing such hole.

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By contradistinction, Claim 9 calls for "the sliding fence having at least one hole for fixing an end stop fixture thereto." Because such feature is not shown in Stumpf, it cannot render Claims 9-10 unpatentable.

The Examiner rejected Claim 12 under 35 USC § 102(e) as being anticipated by Stumpf. The Examiner also rejected Claim 12 under 35 USC § 103(a) as being obvious over Stumpf. These rejections are respectfully traversed.

In response to this rejection, Applicants will assume that the Examiner intended to reject Claim 11 as being anticipated by Stumpf. However, Applicants invite the Examiner to communicate with Applicants' attorney below if such assumption is incorrect so that Applicants' attorney can provide an updated response.

Claim 11 calls for a miter saw comprising a base assembly, a table rotatably attached to the base assembly, and wherein at least one of the base assembly and the table has at least one hole for fixing a fixture thereto.

Admittedly, Stumpf shows a miter saw comprising a base assembly and a table rotatably attached to the base assembly. However, Stumpf does not show at least one of the base assembly and the table has at least one hole for fixing a fixture thereto. Indeed, the Examiner could not find such hole either, as the Examiner did not provide a reference to Stumpf showing such hole.

By contradistinction, Claim 11 calls for "at least one of the base assembly and the table has at least one hole for fixing a fixture thereto." Because such feature is not shown in Stumpf, it cannot render Claims 11-12 unpatentable.

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No fee is believed due. Nonetheless, the Commissioner is authorized to charge payment of any fees due in processing this amendment, or credit any overpayment to Deposit Account No. 02-2548.

In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance.

Respectfully submitted,



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